

REMARKS/ARGUMENTS

Status of the Claims

Upon entry of the present amendment, Claims 1, 3-6, 8 and 12 and 24-33 are pending. Claims 1, 3, 4, 6, 8 and 12 are amended and Claims 2, 7, 9-11 and 13-23 are canceled without disclaimer or prejudice to renewal. New Claims 24-33 are added.

Claims 1 and 6 are amended to incorporate language from Claim 2 as originally filed.

Claim 3 is amended to remove recitation of "a receptor or a part thereof."

Claim 4 is amended to remove recitation of "wound-healing substances."

Claim 8 is amended to depend from Claim 6 and to track the language of Claim 5 as originally filed.

Claim 12 is amended to depend from Claim 6 and to remove recitation of "wound-healing substances."

New Claims 24-33 incorporate language from Claims 1-12 as originally filed.

Objection to Claims 13-16

The Examiner objected to Claims 13-16 because of informalities. This objection is rendered moot by the cancellation of Claims 13-23.

Statutory Double Patenting

The Examiner rejected Claims 13, 14, 16-18 and 21-23 for statutory double patenting under 35 U.S.C. § 101 as claiming the same invention claimed in Claims 1-5 and 8-10 of U.S. Patent No. 6,506,365. This rejection is rendered moot by the cancellation of Claims 13-23.

Non-Statutory Double Patenting

Claims 1-22 of U.S. Patent No. 6,506,365

Claims 1-8, 11, 12, 15, 19 and 20 stand rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,506,365. In response, Applicants are in the process of obtaining an executed Terminal Disclaimer, which will be sent under separate cover.

Claims 1-45 of U.S. Patent No. 6,713,453

Claims 1-23 stand rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,713,453 ("the '453 patent"). This rejection is respectfully traversed because the claims of the '453 patent recite only a VEGF₁₆₅ C-terminal domain fragment fibrin/fibrinogen binding moiety, which is patentably distinct from the specific binding moieties recited in the presently pending claims, including thrombin, fibronectin, bacterial fibrinogen binding proteins, basic fibrinogen growth factor, and integrins.

Common Ownership

Pursuant to 37 C.F.R. § 1.78(c), Applicants here affirm that the inventions claimed in the instant application and in U.S. Patent No. 6,506,365 were commonly owned and subject to an obligation of assignment to the same person at the time the later invention was made.

Rejection under 35 U.S.C. § 102(e) over U.S. Patent No. 6,506,365

The Examiner has rejected Claims 2-4, 11 and 12 under 35 U.S.C. § 102(e) as allegedly anticipated by co-owned U.S. Patent No. 6,506,365, which issued from U.S. Application No. 09/669,240, to which the present invention claims priority. This rejection is respectfully traversed, because a proper rejection under Section 102(e) requires that the invention be described by another. Here, amended claims 1, 3, 4, 6, 8 and 12 properly are entitled to the benefit of the filing date of grandparent application 09/669,240 because claim language directed to disclosure first presented in the continuation-in-part application 09/963,156 has been removed.

Accordingly, the inventive entities are the same between grandparent application 09/669,240 and the inventions of claims 1, 3-6, 8 and 12, and the grandparent application is no longer proper art under Section 102(e) against the inventions of claims 1, 3-6, 8 and 12.

With regard to the inventions of new claims 25-33, grandparent application 09/669,240 also is not proper art under Section 102(e), because the '240 application does not disclose or suggest a fibrin/fibrinogen-binding moiety that is a nucleic acid, a substance capturing moiety that is a receptor or part thereof or a pharmaceutically active substance that is a wound-healing substance. The Examiner concedes on page 4 (paragraph 7) of the present office action (mailed February 18, 2005) that the '240 specification does not disclose or suggest a fibrin/fibrinogen-binding moiety that is a nucleic acid, a substance capturing moiety that is a receptor or part thereof or a pharmaceutically active substance that is a wound-healing substance.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,792,742 (Gold)

The Examiner rejected Claims 7-9, 11 and 12 as allegedly anticipated under 35 U.S.C. § 102(b) by Gold. This rejection is rendered moot by the cancellation of independent Claim 7. Currently pending independent Claims 1 and 6 both require that the fibrin/fibrinogen-binding conjugate comprise a substance capturing moiety. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,364,612 (Goldenberg)

The Examiner rejected Claims 1 and 4-7 as allegedly anticipated under 35 U.S.C. § 102(b) by Goldenberg. This rejection is rendered moot by the incorporation of the Markush group from Claim 2, which was not included in this rejection, into independent Claims 1 and 6. Goldenberg does not disclose or suggest a fibrin/fibrinogen-binding moiety selected from the group consisting of thrombin, fibronectin, bacterial fibrinogen binding proteins, basic fibrinogen growth factor, integrins, and moieties derived from any member of this group. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,328,996 (Boyle)

The Examiner rejected Claims 1 and 3-7 as allegedly anticipated under 35 U.S.C. § 102(b) by Boyle. This rejection is rendered moot by the incorporation of the Markush group from Claim 2, which was not included in this rejection, into independent Claims 1 and 6. Boyle does not disclose or suggest a fibrin/fibrinogen-binding moiety selected from the group consisting of thrombin, fibronectin, bacterial fibrinogen binding proteins, basic fibrinogen growth factor, integrins, and moieties derived from any member of this group. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over Bio/Technology 7:1163 (Kurokawa)

The Examiner rejected Claims 1 and 3-7 as allegedly anticipated under 35 U.S.C. § 102(b) by Kurokawa. This rejection is rendered moot by the incorporation of the Markush group from Claim 2, which was not included in this rejection, into independent Claims 1 and 6. Kurokawa does not disclose or suggest a fibrin/fibrinogen-binding moiety selected from the group consisting of thrombin, fibronectin, bacterial fibrinogen binding proteins, basic fibrinogen growth factor, integrins, and moieties derived from any member of this group. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,217,705 (Reno)

The Examiner rejected Claims 1, 2 and 4-7 as allegedly anticipated under 35 U.S.C. § 102(b) by Reno. This rejection is rendered moot by the incorporation of the Markush group from Claim 2, into independent Claims 1 and 6. Reno does not disclose or suggest a fibrin/fibrinogen-binding moiety selected from the group consisting of thrombin, fibronectin, bacterial fibrinogen binding proteins, basic fibrinogen growth factor, integrins, and moieties derived from any member of this group. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over WO 99/40947 (Fauconnier)

The Examiner rejected Claims 7, 8, 11 and 12 as allegedly anticipated under 35 U.S.C. § 102(b) by Fauconnier. This rejection is rendered moot by the cancellation of independent Claim 7. Currently pending independent Claims 1 and 6 both require that the fibrin/fibrinogen-binding conjugate comprise a substance capturing moiety. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over WO 96/06641 (Sosnowski)

The Examiner rejected Claims 7-12 as allegedly anticipated under 35 U.S.C. § 102(b) by Sosnowski. This rejection is rendered moot by the cancellation of independent Claim 7. Currently pending independent Claims 1 and 6 both require that the fibrin/fibrinogen-binding conjugate comprise a substance capturing moiety. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Rejection under 35 U.S.C. § 102(b) over U.S. Patent No. 5,688,935 (Stephens)

The Examiner rejected Claims 7, 8, 11 and 12 as allegedly anticipated under 35 U.S.C. § 102(b) by Stephens. This rejection is rendered moot by the cancellation of independent Claim 7. Currently pending independent Claims 1 and 6 both require that the fibrin/fibrinogen-binding conjugate comprise a substance capturing moiety. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Appl. No. 10/749,832
Amdt. dated June 20, 2005
Reply to Office Action of February 18, 2005


PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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Attachments
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